

REMARKS

Claims 1, 4-7, 10-13, and 16-21 are pending.

Claims 1, 4-7, 10-13, 16 and 20 are rejected. Claims 17-19 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 U.S.C. § 112

Claim 10 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 10 has been amended to overcome the rejection.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 5-7, 11-13 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,304,250 issued to Yang (referred to herein as "Yang") in view of U.S. Patent No. 5,880,729 issued to Johnston, Jr., et al. (referred to herein as "Johnston").

Claims 4, 10 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yang in view of Johnston, and further in view of U.S. Patent No. 6,178,527 issued to Vidales (referred to herein as "Vidales").

Response to Rejection of Independent Claims 1, 7, and 13

Independent claims 1, 7, and 13 are directed to a system and method for an improved user interface device that comprises a keyboard switch matrix having a plurality of rows and columns. Each of the aforementioned independent claims recites that the user input device further comprises a scan circuit that is operable detect operation of a key associated with the user device by detecting a transition in the voltage level of at least one row in the switch matrix from a first state to a second state and thereafter forces said row back to said first state thereby decreasing the scanning interval for detecting row transitions.

In the Office Action dated November 1, 2005, Examiner has rejected independent claims 1, 7, and 13 under 35 U.S.C. §103 as being unpatentable over Yang in view of Johnston. Yang

discloses a keyboard comprising a switch matrix. However, Examiner concedes that Yang "does not explicitly teach 'forcing back' to a first state, 'thereby decreasing the scanning interval for detecting row transitions,' as claimed by Applicant." (Office Action, Pages 4, 5 and 7) Examiner contends, however, that "Johnston teaches an input device, which transitions from a first to a second state (see col. 5, lines 1-5) and returns to its first ("original") state."

Applicant respectfully traverses the rejection of independent claims 1, 7, and 13 under 35 U.S.C. §103. First, the Johnston reference does not teach a scanning circuit that "forces a row of a switch matrix back to a first state thereby decreasing the scanning interval for detecting row transitions." Second, the proposed combination of Johnston with Yang is improper because Johnston constitutes nonanalogous art. Finally, Examiner has failed to provide a motivation to combine Yang and Johnston in accordance with the standards established for rejecting claims under 35 U.S.C. §103.

The Johnston reference relates to graphical user interfaces. The first paragraph of the background section of Johnston states "[m]ore particularly, the [Johnston] invention relates to systems and methods for interfacing applications and operating systems which provide for animated control elements in graphical user interfaces." The portion of the Johnston text (col. 5, lines 1-5) cited by Examiner states: "After the mouse button is released, the control returns back to its original state (state Q1) and the application is notified of the button which has been pressed." The control referred to in the cited portion of Johnston is a graphical user interface software control, as is apparent from the discussion beginning in column 3, line 65 and continuing to column 5, line 18. Johnston does not provide any teaching of rows in a switch matrix and does not provide any teaching of "forcing" a row of a switch matrix to a particular state. Therefore, the limitations recited in independent claims 1, 7, and 13 have not been met and, therefore, the rejection of these claims under 35 U.S.C. §103 is improper.

As discussed above, Applicant respectfully submits that the combination of Yang and Johnston is also improper because Yang and Johnston are nonanalogous prior art that have been combined with the benefit of hindsight. Yang and Johnston are nonanalogous prior art because Yang relates generally to user input devices, such as keyboards, and Johnston relates generally to software applications, specifically graphical user interfaces.

The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d, 1443, 1446 (Fed. Cir. 1992)

Further, it appears that the rejection of independent claims 1, 7 and 13 is based on an improper hindsight-based obviousness analysis. In this regard, it must be recognized that hindsight reconstruction of claims based on disparate aspects of the prior art may not be employed as a valid basis for the rejection of those claims. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1983); *Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593, 1595-1596 (Fed. Cir. 1987). Furthermore, an obviousness determination requires that the invention *as a whole* would have been obvious to a person having ordinary skill in the art. *Connell v. Sears Roebuck & Co.*, 220 USPQ 193 (Fed. Cir. 1983).

To establish obviousness based on a combination of elements disclosed in the prior art or a modification of the prior art, there must be some motivation, suggestion or teaching of the desirability of making the claimed invention. *See In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The motivation, suggestion or teaching to modify references may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Whether the Office Action relies on an express or implicit showing of a motivation or suggestion to modify or combine references, it must provide particular findings related thereto. *In re Dembiczak*, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." *Id.* Thus, the Office Action must include particular *factual findings* that support an assertion that a skilled artisan would have modified the express disclosure of Yang to develop the invention recited by independent claims 1, 7 and 13. *See In re Kotzab*, 55 USPQ2d 1313, 1317. Applicant is unable to discern the requisite factual basis in Yang, Johnston or the Office Action.

Examiner states that the Abstract of the Johnston reference provides a basis for motivation to modify Yang with the teachings of Johnston. The text of the Abstract of the Johnson reference is set forth below:

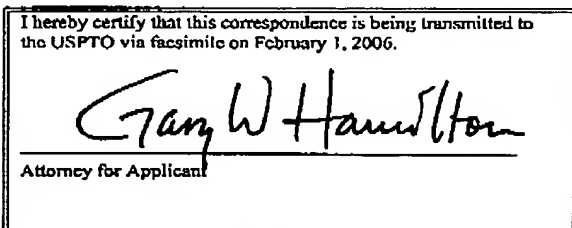
Systems and methods for providing an enhanced visual appearance to a graphical user interface are described. Control elements portrayed by the graphical user interface on a display are associated with at least two states. When transitioning between states, an animated transition effect can be provided to provide further user or designer customization of the interface appearance. (Entire Text of Abstract, U.S. Patent 5,880,729)

Attorney for Applicant is unable to discern any statements in the Abstract of the Johnson reference that would provide a motivation to modify Yang as suggested by Examiner.

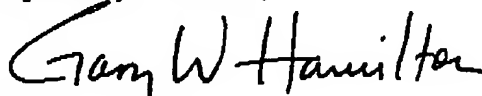
For the reasons set forth above, Applicant respectfully submits that independent claims 1, 7 and 13 are allowable over the art of record. In addition, all remaining claims are allowable as being dependent from allowable base claims.

CONCLUSION

In view of the amendments and remarks set forth herein, Applicant respectfully submits that all pending claims are in condition for allowance. Accordingly, Applicant requests that a Notice of Allowance be issued. Nonetheless, should any issues remain that might be subject to resolution through a telephone interview, the Examiner is requested to telephone the undersigned at 512-338-9100.



Respectfully submitted,



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